

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1606.72574

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

10/525,900

Filed

February 25, 2005

First Named Inventor

Claude Pommereau

Art Unit

3653

Examiner

Michael E. Butler

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 48,244
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Christopher S. Hermanson/

Signature

Christopher S. Hermanson

Typed or printed name

312-360-0080

Telephone number

August 14, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

1606.72574

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application)
)
Applicant: Claude Pommereau)
)
Serial No. 10/525,900)
)
Conf. No. 9652)
)
Filed: February, 25 2005)
)
For: GOLF BALL DISPENSER)
)
Art Unit: 3653)
)
Examiner: Michael E. Butler)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests a pre-appeal review of the outstanding final rejections of the pending claims in this Application based upon the attached remarks.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

August 14, 2009
300 South Wacker Drive,
Suite 2500
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978

By /Christopher S. Hermanson/
Christopher S. Hermanson
Registration No. 48,244

Pre-Appeal Brief Request for Review

Remarks

An inadequate examination is demonstrated by the record of this prosecution and, in particular, unsupported misrepresentations of the applied prior art and omission of several claim features from consideration. Fairness dictates that the rejections be withdrawn and the Application allowed without subjecting Applicant to the delay and expense of a full appeal.

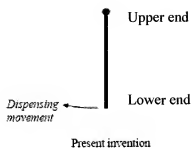
I. Applicant Intends to Amend Claim 1 to Overcome the Indefiniteness Rejection Under § 112

The pending claims, claims 1, 7-8 and 28-29, are rejected under § 112 because the Examiner states that the terms “or” and “without” in the final line of claim 1 are indefinite. Applicant intends to amend claim 1 so that the final line states that the dispensing arm returns to the rest position from the dispensing positions “without a spring and without a counterweight.” As described below, the present golf ball dispenser moves from the dispensing position back to the rest position using solely gravity and without any type of spring and without any type of counterweight to assist that movement.

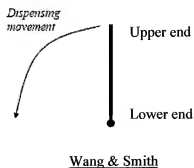
II. The Examiner Clearly Misrepresents the Content of Wang and Ignores Required Claim Features

Claim 1 of Applicant’s application recites, among other things, a golf ball dispenser that includes an upper container that holds the golf balls and a dispenser arm, where the dispenser arm includes “an upper part close to the flange to receive balls one by one from the container, a lower end intended to dispense balls, and a pivoting means arranged in the upper end of the dispenser arm close to the flange for pivoting about a horizontal axis” to dispense a golf ball. As shown in the diagram below, the dispenser arm pivots at the upper part or end and also receives

golf balls at this end. The lower end of the dispenser arm moves laterally and upwardly to dispense the golf balls on a tee.



In contrast, as stated on page 9 of Applicant's response filed January 21, 2009, Wang discloses a supply arm 32 pivotally mounted in and normally vertically erected on a housing 1. As shown in Figs. 3 and 4 of Wang, the upper part or end 323 of the pivotal supply arm 32 dispenses the balls and the lower part or end 34 receives the balls from the channel 13 in the housing. The supply arm 32 is mounted around a pivot 31 arranged at the lower end of the pivotal supply arm 32. Thus as shown in the diagram below, the supply arm 32 in Wang pivots and receives golf balls at the lower end of the arm where the arm pivots downwardly to dispense the balls at the upper end of the arm.



The Examiner therefore misrepresented the teachings of Wang because Wang discloses an arm that pivots about its lower end and also receives golf balls at the lower end and dispenses the balls at its upper end. This is contrary to claim 1, which recites the opposite configuration, where the arm pivots about and receives golf balls at the upper end and dispenses golf balls at the lower end. The configuration of Applicant's golf ball dispenser is an advantage over existing golf ball dispensers, such as the dispenser disclosed by Wang, because the arm in Applicant's dispenser moves due to gravity and does not require additional parts, such as springs and/or counterweights, for such movement, which can rust or break over time and add additional cost.

Additionally, Wang is missing a required element or feature of claim 1. In particular, claim 1 recites, among other things, that the dispensing arm of the golf ball dispenser returns to "said rest position from said dispensing position without a spring or a counterweight." (Emphasis Added). Wang discloses that its arm 32 includes a counterweight 4 to cause the arm 32 to pivot back to the rest position shown in Fig. 3 (see Col. 4, lines 23-31). Wang therefore fails to disclose a golf ball dispenser having a dispensing arm that moves without a counterweight as recited in claim 1 of Applicant's application.

For at least these reasons, Applicant submits that the rejection of the claims over Wang is improper and requests that the rejection be withdrawn.

III. The Examiner Clearly Misrepresents the Content of Smith and Ignores Required Claim Features

The golf ball teeing apparatus in Smith has a similar operation to the golf ball dispenser in Wang. Smith discloses a teeing apparatus that includes a pivotal supply arm 20 including an upper end or supply part 54 and a lower end having a feeding part that receives the golf balls. The arm 20 pivots about a pivot 48 located at the lower end of the arm. As shown in the diagram above for Smith, the upper end of the arm 20 pivots about the lower end so that the upper end

moves downwardly from the rest position to the dispensing position. In contrast, claim 1 recites that the upper end or upper part of the dispensing arm includes the pivoting means and receives the balls to dispense the balls from the lower end of the arm.

For this reason, Applicant submits that the Examiner misrepresented Smith in rejection the claims in Applicant's application and thereby requests that the rejection be withdrawn.

Applicant further submits that Smith does not disclose all of the features of claim 1. Claim 1 recites, among other things, that the dispensing arm returns to the "rest position from said dispensing position without a spring." (Emphasis Added). Smith clearly discloses a spring 56 having one end secured to the front wall 38 and a second end 59 secured to the bracket 50 to bias the arm 20 upwardly from the dispensing position to the rest position (see Figs. 1 and 2; Col. 5, lines 34-40). Smith therefore fails to disclose the subject matter of claim 1.

For at least these reasons, Applicant submits that the rejection of the claims over Smith is improper and requests that the rejection be withdrawn.

IV. The Examiner Clearly Misrepresents the Content of Hodgin to Reject Claim 29

Claims 1 and 28-29 are rejected as being unpatentable over the combinations of Smith and Hodgin and Wang and Hodgin. In particular, the Examiner states that Hodgin discloses the subject matter of claim 29. Claim 29 depends from claim 28 and further recites that the non-concentric rings of the dispenser arm "are arranged so that at he distance between two consecutive rings decreases closer to the lower end of the dispenser arm." Hodgin does not disclose such subject matter.

Hodgin discloses a golf ball teeing device 10 including a pivoting arm 28 having a dispensing end 80 with two ring-like structures (see Fig. 2). There are only two ring structures disclosed by Hodgin, which are separated by a designated distance. Hodgin does not disclose

additional ring structures where the distance between the ring structures decreases closer to the lower end of the dispenser arm. It is impossible for the distance between the ring structures to “decrease” where there are only two ring structures shown having a single distance or space between them.

Applicant therefore submits that the Examiner clearly erred in rejecting claim 29 over the combinations of Smith and Hodgin and Wang and Hodgin where Hodgin fails to disclose the subject matter of claim 29.

For at least this reason, Applicant submits that the rejection of the claims over the combinations of Smith and Hodgin and Wang and Hodgin are improper and requests that the rejections be withdrawn.

V. Conclusion

Applicant asks that this pre-appeal review request be sustained, and the Application allowed. As no sufficient rejections have been established, the pendency of this Application should be ended with issuance of Notice of Allowance.

August 14, 2009
300 South Wacker Drive,
Suite 2500
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By
/Christopher S. Hermanson/
Christopher S. Hermanson
Registration No. 48,244